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Remarks

Claims 11-13 and 15-22 are pending, claims 1-10 and 14 having been cancelled. Claim 11 is the only independent claim. Reconsideration and reexamination of the application is respectfully requested.

The new claims 18-22 have been added which define subject matter disclosed originally at page 4, line 19 to page 5, line 1.

The independent claim 11 has been amended to include the technical aspect of applicant's invention as originally disclosed, e.g. in the previous dependent claim 14, and at page 4, lines 17-18 of applicant's original disclosure, and now provided with a clearer definition according to which the vulcanizable rubber comprises a vulcanizable nitrile-based rubber and at least one hydroxyl acrylic resin. It is submitted that such improved definition allows to overcome the previous rejection of claim 14 under 35 U.S.C. 112, second paragraph, and such previous claim 14 has also now been cancelled. The claim 15, previously dependent upon claim 14, has not been appropriately amended to be dependent upon the newly amended independent claim 11.

It is furthermore respectfully submitted that the amendment to the independent claim 11 also allows to overcome the rejection under 35 U.S.C. 103(a) set forth in the pending Office action, based upon Barma US 4,858,337 or Fujii *et al.* US 6,489,385.

In fact, both Barma and Fujii *et al.* do not teach nor fairly suggest, to a

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person having ordinary skill in the art, a vulcanizable rubber comprising at least one hydroxyl acrylic resin. Specifically, the cited **Barma** includes no disclosure or fair suggestion of a hydroxyl acrylic resin, and the cited **Fujii et al.** while disclosing general "acrylic acid" substances, also does not disclose nor fairly suggest a hydroxyl acrylic resin as specifically required in applicant's newly submitted independent claim 11.

Applicant's claimed invention achieves advantageous results that are surprising and unexpected over the teachings of the prior art of record.

In particular, the claimed hydroxyl acrylic resin in the vulcanizable rubber provides an efficient and effective adhesion function when the rubber is coupled for example with polyurethane, as in the case of shoes having a tread sole in such claimed vulcanizable rubber and a mid-sole in polyurethane. The hydroxyls in the acrylic resin of the vulcanizable rubber provide an excellent coupling with for example free isocynate groups present in the polyurethane, and such hydroxyls in the acrylic resin also remain unaltered even at high vulcanization temperatures of the rubber. Applicant submits that these combined advantageous results are surprising and unexpected over the teachings of the prior art of record, which offers no teachings or suggestions to a person having ordinary skill in the art to arrive at the claimed combination for achieving such advantageous results.

Finally, the provisional obviousness-type double patenting rejection based upon co-pending Application No. 10/450,567. It is respectfully submitted that such rejection is not proper due to the fact that in the instant

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application the claims are directed to a vulcanizable rubber product whereas in the co-pending Application No. 10/450,567 the claims are directed instead to a process for manufacturing a sole for shoes. It is pointed out further that in such co-pending Application No. 10/450,567 a terminal disclaimer directed to the instant application has already been filed and accepted by the Office, hence if the instant application issues before such co-pending Application No. 10/450,567 there should be no problem with obviousness-type double patenting rejection in either application.

In view of the foregoing, allowance of pending claims 11-13 and 15-22 is respectfully requested.

Respectfully submitted,



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